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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,719	08/05/2003	Adam Warwick Bell		8422

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ADAM BELL  
416 FUNSTON AVENUE  
SAN FRANCISCO, CA 94118

EXAMINER
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COHEN, AMY R

ART UNIT	PAPER NUMBER
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2859

DATE MAILED: 11/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No. 10/634,719	Applicant(s) BELL ET AL.	
	Examiner Amy R Cohen	Art Unit 2859	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 August 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 7 are rejected under 35 U.S.C. 102(b) as being anticipated by McCreary (U.S. Patent No. 5,429,244).

McCreary teaches a portable device (10) wherein the device is easily carried by a single user (Col 4, lines 45-49), the device comprising an inflatable figure (12) that increases rapidly in size upon activation by the user (Col 2, lines 27-54 and Col 3, lines 45-64).

McCreary teaches the device wherein the device is fully detachable from the user (Fig. 6, pouch 54).

McCreary teaches the device wherein the device is detachably associated with an item selected from the group consisting of: a knapsack (Fig. 6, pouch 54), an item of luggage, and a walking-stick (Examiner notes: in the case of a list of alternative items listed in claims, only one item needs to be taught by the reference in order to fulfill the claim language.)

McCreary teaches the device wherein the device is a self-contained portable unit (54) that can be placed in a back-pack or side pocket of a knapsack for easy access, or carried in the hand (Col 2, lines 27-54 and Col 4, lines 45-49).

Regarding claim 1, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a

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prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). The subject matter considered to be intended use of the apparatus is “for deterring an attack by an animal upon a user” and “scaring the animal and deterring an attack.”

3: Claims 1, 2, 5, 8, 9, 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Clayton (UK Patent Application GB 2156645A).

Clayton teaches a portable device (1) for deterring an attack by an animal upon a user, wherein the device is easily carried by a single user (“easily carried” is a relative term, in this case, the device (1) needs to be set up by a user, and therefore, is considered to the “easily carried” by a user from or to a location), the device comprising a figure (3) that increases rapidly in size upon activation by the user, thereby scaring the animal and deterring the attack upon the user (Col 1, lines 5-28).

Clayton teaches the device wherein the device is fully detachable from the user (Fig. 1, the device is not attached to a user and therefore, is considered “detachable from a user”).

Clayton teaches the device wherein the molded and shaped inflatable shell comprises a material selected from the group consisting of: a plastic material, a rubber material and a polymer material (Col 2, lines 78-94), and wherein the figure is inflated by a gas released from a pressurized gas container (Col 1, lines 46-52).

Clayton teaches the device wherein activation is accompanied by the production of a loud noise (Col 1, lines 29-41 and Col 2, lines 121-125).

Clayton teaches the device wherein the noise is selected from the group consisting of: an explosion, a horn, a whistle, and a shout (Col 1, lines 29-41).

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Clayton teaches a method for deterring an attack by an animal upon a user using the device, the method comprising activating the device wherein the device increases rapidly in size, thereby scaring the animal and deterring the attack upon the user (Col 1, lines 29-41).

4. Claims 1, 2, and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Willis et al. (U. S. Patent No. 5,582,127).

Willis et al. teaches a portable device (10) wherein the device is easily carried by a single user (Col 2, lines 55-61), the device comprising an inflatable figure (40) that increases rapidly in size upon activation by the user (Col 3, lines 7-47).

Willis et al. teaches the device wherein the device is fully detachable from the user (Col 2, lines 55-61).

Willis et al. teaches the device wherein the device is detachably associated with an item of clothing (the belt, Col 2, lines 55-61).

Regarding claim 1, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). The subject matter considered to be intended use of the apparatus is “for deterring an attack by an animal upon a user” and “scaring the animal and deterring an attack.”

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clayton.

Clayton discloses the device as described above in paragraph 3.

Clayton does not disclose the device wherein the device is fully inflated within 5 seconds.

Regarding the time of inflation: Clayton discloses a device having a time value for full inflation but does not disclose a particular value for this parameter. However, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide a value of full inflation within 5 seconds, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the "optimum range" involves only routine skill in the art. *In re Aller*, 105 USPQ 233. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the device fully inflate within 5 seconds so that the timing of the device will be short enough and accurate enough to scare an animal as it approaches, as already suggested by Clayton (Col 1, lines 5-52).

7. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clayton in view of Gaskill (U. S. Patent No. 4,890,571).

Clayton discloses the device as described above in paragraph 3.

Clayton does not disclose the device wherein the device is accompanied by the production of a smell; wherein the smell is a smell similar to that of an animal.

Gaskill discloses a device (Fig. 2) wherein the device is accompanied by the production of a smell (16); wherein the smell is a smell similar to that of an animal (Col 3, lines 17-40).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Clayton to include production of a smell, as taught by Gaskill,

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so that the device would further deter an animal by emitting a smell that would naturally deter the animal from approaching (Gaskill, Col 3, lines 17-40).

8. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clayton in view of Gibbs (U. S. Patent No. 1,730,815).

Clayton discloses the device as described above in paragraph 3.

Clayton does not disclose the device wherein activation is accompanied by the production of smoke; wherein the smoke is produced by a pyrotechnic device.

Gibbs discloses a device (Fig. 1) wherein activation is accompanied by the production of smoke; wherein the smoke is produced by a pyrotechnic device (Col 1, line 42-Col 2, line 63).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Clayton to include production of smoke, as taught by Gibbs, since both the odor and sight of fire (and hence, smoke) is frightening to animals and would deter animals from approaching (Gibbs, Col 1, line 42-Col 2, line 63).

9. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clayton in view of Stonebraker (U. S. Patent No. 6,257,146).

Clayton discloses the device as described above in paragraph 3.

Clayton does not disclose the device wherein activation is accompanied by the launching of one or more projectiles.

Stonebraker discloses a device wherein a sound producing deterrent is launched in a projectile (Col 1, lines 5-22).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Clayton so that the sound is produced by launching projectiles,

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as taught by Stonebraker, to further deter an animal by producing a very loud noise over a larger area, and since the sound of a projectile launching would frighten the animal.

10. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clayton in view of Rakonjac (U. S. Patent No. 4,895,546).

Clayton discloses the device as described above in paragraph 3.

Clayton does not disclose the device wherein the figure, when inflated is shaped in the form of a bear.

Rakonjac discloses a device wherein the figure, when inflated is shaped in the form of a type of a bear (Col 1, lines 5-15).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Clayton to be of the form of a bear, as taught by Rakonjac, so that the device could be used to deter a different animals depending on the fears of the animal to be deterred.

### ***Response to Arguments***

11. Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.

12. In response to applicant's argument that the Clayton device is not "easily carried by a single user", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use



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must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Examiner notes that “easily carried” is a relative term, in this case, the device (1) of Clayton needs to be set up by a user, and therefore, is considered to the “easily carried” by a user from or to a location.

Regarding Applicant’s arguments of the previous rejection of claim 6, and therefore also the current rejection of claim 6, Examiner asserts that the device of Clayton is intended to be used as a deterrent for an attack, and as a scaring device (Clayton, Abstract).

13. In response to applicant's argument that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., “to deter a bear attacking a user on the move”) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

14. Regarding Applicant’s Arguments of claims 3, 4, 7, see the new rejections in paragraphs 2 and 4 of this Office Action.

Examiner notes: in the case of a list of alternative items listed in claims, only one item needs to be taught by the reference in order to fulfill the claim language.

15. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the

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applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the case of claims 10-15, the references used to modify the Clayton device enhance the deterring capabilities of the device, and therefore are considered proper.

### *Conclusion*

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patent discloses a portable signaling device Key et al. (U. S. Patent No. 6,523,778).

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

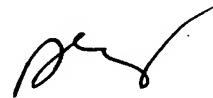
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18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy R Cohen whose telephone number is (571) 272-2238. The examiner can normally be reached on 8 am - 5 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F. Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ARC  
November 15, 2004



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